

Appl. No. 10/052,733
Atty. Docket No. G-262M (CP-1221)
Amdt. Dated March 7, 2005
Reply to Office Action of December 6, 2004
Customer No. 27752

REMARKS

Application Amendments

Claim 1 is pending in the present application. Claims 2-15 have been withdrawn from consideration. No claim amendments have been made.

Rejections Under 35 USC 103(a) Over US Patent No. 5,073,174 to Vayssie et al.

Claim 1 is rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5,073,174 to Vayssie et al. ("Vayssie"). The Examiner asserts that Vayssie discloses 2-hydroxymethyl-4-aminophenol and 2-(β -hydroxyethyl)-4-aminophenol as useful hair dye precursors. The Examiner notes that Vayssie does not disclose Applicants' claimed compound. However, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to use Applicants' claimed compound as a hair dye intermediate because Vayssie discloses that a one-carbon homolog and a simple structural isomer of Applicants' claimed compound have the same utility as that disclosed by Applicants. Thus, the Examiner asserts that one of ordinary skill in the art would expect Applicants' claimed compound to have similar properties. Applicants respectfully traverse the present rejection based on the following comments.

Vayssie does not teach or suggest all of Applicants' claim limitations, and, therefore, does not establish a *prima facie* case of obviousness (MPEP 2143.03). Specifically, Vayssie fails to teach or suggest a method of making Applicants' claimed compound. "[I]f the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public." *In re Hoeksema*, 399 F.2d 269, 274, 158 U.S.P.Q. 596 (C.C.P.A. 1968). Indeed, "the absence of a known or obvious process for making the claimed compounds overcomes the presumption that the compounds are obvious, based on close structural relationships between their structures and those of prior art compounds." *Id.* Furthermore, "the mere naked statement of the invention does not put anyone in possession of the invention." *Id.* (citing *Phillips Petroleum v. Ladd*, 219 F.Supp. 366, 138 U.S.P.Q. 421 (D.D.C. 1963)).

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Applicants' claim 1 is directed to the compound of 4-amino-2-(1-hydroxy-ethyl)-phenol. Applicants' claimed compound is a suitable primary intermediate for hair coloring compositions and provides good oxidative coloration to hair while avoiding the drawbacks of p-aminophenol. In the specification of the present application, Applicants disclose a synthesis procedure and a synthesis example for the claimed compound.

The Examiner relies upon Vayssie in asserting that Applicants' claimed compound is obvious. Vayssie is directed to compositions and processes for dyeing hair which employ certain 5,6-dihydroxyindole compounds. While the Examiner notes that Vayssie does not disclose 4-amino-2-(1-hydroxy-ethyl)-phenol, the Examiner cites Vayssie's disclosure of the allegedly structurally similar compounds of 2-hydroxymethyl-4-aminophenol and 2-(β -hydroxyethyl)-4-aminophenol. However, the disclosure of these compounds in Vayssie is merely a listing of their chemical names among numerous other para dye precursors which are suitable for use in hair dyeing compositions of Vayssie. There is no further disclosure regarding these allegedly structurally similar compounds in Vayssie. Most importantly, the disclosure of Vayssie fails to teach or suggest a method of making these allegedly structurally similar compounds, let alone a method of making Applicants' claimed compound. Moreover, the Examiner has not provided any additional proof that a method of making Applicants' claimed compound was already in possession of the public at the time the invention was made.

Therefore, consistent with the holding of *Hoeksema*, in which the court reversed its previous affirmation of the Patent Office Board of Appeals' rejection of the appellant's chemical compound claim because the Patent Office did not produce proof that the appellant's invention was obvious, Vayssie does not establish a *prima facie* case of obviousness with respect to Applicants' claim 1. Indeed, the Examiner merely concludes that Applicants' claimed compound would have been obvious to one of ordinary skill in the art because of the "mere naked" disclosure of allegedly structurally similar compounds. Accordingly, claim 1 is novel and nonobvious over Vayssie and any modification thereof.

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CONCLUSION

In light of the remarks presented herein, it is requested that the Examiner reconsider and withdraw the present rejections. Early and favorable action in the case is respectfully requested.

Applicant has made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicant respectfully requests reconsideration of this application and allowance of Claim 1.

Respectfully submitted,

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